

REMARKS

Applicant requests favorable reconsideration and withdrawal of the rejection set forth in the above-identified Office Action in view of the following remarks.

Claims 1-11 remain pending, with claims 1 and 9-11 being independent. Claims 1, 2, 6, 7, and 9-11 have been amended. Support for the amendments can be found throughout the originally-filed disclosure. Accordingly, Applicant submits that the amendments do not include new matter.

Claims 1-11 are rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Motoyama (U.S. Patent Application Pub. No. 2002/0030836) in view of Ett (U.S. Patent No. 5,227,893).

Applicant respectfully traverses the rejection. Nevertheless, in order to expedite prosecution, the claims have been amended to clarify certain features of the invention not disclosed or suggested by the cited references. To this end, Applicant submits that the claimed invention is patentably distinguishable from the cited references for at least the following reasons.

Independent claim 1 has been amended to recite an image processing apparatus comprising, inter alia, a first input unit configured to input first data created by predetermined application software, and a second input unit configured to input second data, to which the first data is converted. Amended claim 1 also recites a designation unit configured to designate a transmitting unit or a printing unit as an output method of data, and an index input unit configured to input the specific index. Amended claim 1 further recites a selecting unit configured for selecting the first data, but not the second data, corresponding to the specific index input by said index input unit in a case where the transmitted unit is designated by the

designation unit, and to select second data, but not the first data, corresponding to the specific index input by the index input unit in a case where the printing unit is designated by the designation unit, and a control unit configured to control the transmitting unit to transmit the first data selected by the selecting unit and to control the printing unit to perform print processing based on the second data selected by the selecting unit. Amended independent claim 9 recites an image processing method that recites steps analogous to features recited in the image processing apparatus of amended independent claim 1, amended independent claim 10 recites a program which causes a computer to execute steps analogous to features recited in the image processing apparatus of amended independent claim 1, and amended independent claim 11 recites a program stored on a computer-readable medium, including code for causing a computer to execute image processing steps that are analogous to the features recited in amended independent claim 1.

The Office Action cites Motoyama as disclosing features of the claimed invention. In particular, the Office Action asserts that Motoyama discloses a second input means for inputting second data converted into image data of a predetermined format on the basis of the first data, citing paragraphs [0037] and [0038] of the reference.

Applicant submits, however, that Motoyama cannot be understood to disclose or suggest the second input unit of the amended claims. That is, Motoyama does not disclose or suggest the second input unit configured to input second data, to which the first data is converted. Rather, Motoyama simply discloses independently reading a first input and a second input, and then merging the first and second inputs into a merged image. See paragraphs [0034]-[0035], [0037]-[0039]. However, the first input and the second input are entirely unrelated to one another. More specifically, Motoyama discloses a first image to be merged as a “registered” image, such

as a “Confidential” stamp, to be overlaid on a second image such a document, thereby providing a document containing a “Confidential” stamp. See paragraphs [0050-0051]; Fig. 10-12. The images are thus unrelated to one another, and are certainly not conversions of one another. Accordingly, Motoyama does not disclose or suggest second data, to which the first data is converted, as recited in amended independent claim 1.

The Office Action further asserts that Motoyama discloses control means which automatically selects the first data, but not the second data, in response to a designation by a designation means of a transmission as the output method, and automatically selects the second data, but not the first data, in response to a designation by said designation means of a printing as the output method. The Office Action appears to equate a function of “the merged image data... routed to any one of a number of locations” in Motoyama (Paragraph [0040]) to these features of the claimed invention.

Applicant submits, however, that Motoyama cannot be understood to disclose or suggest the selecting unit of the amended claims. In particular, Motoyama does not disclose or suggest a selecting unit selecting the first data, but not selecting the second data, in a case where a transmitting unit is designated by a designation unit. Motoyama further fails to disclose or suggest the selecting unit selecting the second data, but not selecting the first data, in a case where a printing unit is designated by the designation unit. Rather, Motoyama merely appears to disclose that the merged image data can be routed to various destinations such as a printer, host computer, of facsimile. More specifically, Motoyama discloses:

The multi-function machine 10 then provides a prompt to read the first input (block 106). As before, the prompt may be provided on LCD 36, or on the monitor 82 of host computer 80.

The first input may be image data from host computer 80, scanned image data, or stored facsimile image data.

The multi-function machine 10 then provides a prompt to read the second input (block 108). The prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The second input may be any of a number of classes of image data, as was the case with the first input.

Subsequently, the merge operation transpires (block 110). The nature of the merge operation has been described in relation to FIGS. 4 and 5, and will be more fully described below.

Finally, the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output.

Paragraphs [0037-0040], emphasis added. As such, Motoyama clearly discloses that the merged image data (ie. the **overlay** of the **first** data and the **second** data) is routed to a particular destination. Thus, Motoyama cannot be understood to disclose or suggest a selecting unit which selects the first data, but **not** the second data, in a case where a transmitting unit is designated, and which selects the second data, but **not** the first data, in a case where a printing unit is designated, as recited in amended independent claims 1, 9, 10, and 11.

Applicant further submits that Motoyama cannot be understood to disclose or suggest the control unit of the amended claims. As mentioned in the preceding remarks, Motoyama merely discloses that the **merged** image data is routed to a particular destination. Thus, during the destination-routing process, Motoyama no longer discriminates between the first data and the second data, and only handles the merged (ie. overlaid) data. As such, Motoyama cannot be understood to disclose or suggest a control unit configured to control a transmitting unit to transmit the **first** data selected by said selecting unit and to control a printing unit to perform

print processing based on the **second** data selected by the selecting unit, as recited in amended independent claims 1, 9, 10, and 11. Indeed, Motoyama, at most, alludes to the facsimile and printing of **merged** data.

Applicant further submits that the secondary citation to Ett fails to cure the deficiencies of Motoyama. Ett is cited in the Office Action as disclosing a printing means for printing an image obtained by synthesizing the information representing the index and the second data input by a second input means. In Applicant's view, however, Ett does not disclose or suggest the second input unit, the selecting unit, and the control unit, which, as described above, are also not disclosed or suggested by Motoyama.

For at least the foregoing reasons, Applicant submits that neither Motoyama nor Ett, whether considered independently or in combination, can be understood to disclose or suggest all of the features of the image processing apparatus recited in amended independent claims 1, 9, 10, and 11 of the present application.

The remaining claims in the present application are dependent claims that depend directly or indirectly from one of the independent claims, and are, therefore, patentable over the cited references, for at least the reasons noted above. In addition, each of these claims recite features of the invention still further distinguishing it from the cited references. Favorable and independent consideration thereof is respectfully sought.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and early passage to issue of the application are earnestly solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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